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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/787,470

02/26/2004

Satoshi Takasaka

PC 26222A

9092

28880 7590 02/22/2007  
WARNER-LAMBERT COMPANY  
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EXAMINER

CLAYTOR, DEIRDRE RENEE

ART UNIT

PAPER NUMBER

1617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/22/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/787,470	<b>Applicant(s)</b> TAKASAKA, SATOSHI	
	<b>Examiner</b> Renee Claytor	<b>Art Unit</b> 1617	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments filed 12/21/2006 have been fully considered but they are not persuasive. Applicant argues that sildenafil demonstrates antinociceptive activity in two of the four animal models of pain utilized in the Jain et al. study and that the Jain et al. reference is silent regarding whether these animal models can be correlated with pain associated with spinal cord injury. Applicants further argue that the Cardenas reference does not teach or suggest that sildenafil may be used to alleviate pain or spasticity in a patient suffering from spinal cord injury. This argument is not persuasive because even though Jain does not specifically teach spinal cord injury, Jain does not specify any type of injury associated with pain. The article is drawn to pain in general and uses different animal models to assess pain. Further, Jain et al. concludes that sildenafil produces antinociception. While Jain et al. does not specifically teach pain associated with spinal cord injury, Cardenas et al. demonstrate that pain is associated with spinal cord injury.

Applicant's further argument over the inclusion of the Maw reference, stating that Maw does not render obvious the treatment of pain or spasticity in a patient suffering from spinal cord injury by the administration of sildenafil. The inclusion of the Maw reference fills in the deficiencies of Jain et al. and Cardenas et al. because Maw et al. teach oral administration of sildenafil and therapeutic dose ranges.

Applicant's amendments filed on 12/11/2006 to the Specification are sufficient to overcome the Objection to the Specification. In view of Applicant's response and claim

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amendments, the Objection to the Specification is overcome by Applicant's amendments to the Specification, the 35 U.S.C. 112-1<sup>st</sup> paragraph and 112-2<sup>nd</sup> paragraph are overcome, and the following modified 35 U.S.C. 103(a) rejection is being made.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 rejected under 35 U.S.C. 103(a) as being unpatentable over Jain et al (Brain Research 909, 2001, 170-178) in view of Cardenas et al. (Arch Phys Med Rehabil Vol. 83, Dec. 2002).

Jain et al. teach that sildenafil is a cGMP PDE5 inhibitor that is useful in the treatment of pain (see in particular results and figures).

Jain et al. does not specifically teach that sildenafil or cGMP PDE5 inhibitors treat pain associated with spinal cord injury.

Cardenas et al. teach that chronic pain is associated with spinal cord injury (see whole document).

It is therefore obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Jain et al., which teach that sildenafil is a cGMP PDE5 inhibitor and is useful in the treatment of pain, with Cardenas et al. which teach that pain is associated with spinal cord injury. One having ordinary skill in the art

at the time the invention was made would be motivated to combine the teachings of Jain et al., with Cardenas et al. because the prior art teaches that sildenafil treats pain and spinal cord injury is associated with pain.

Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jain et al. (Brain Research 909, 2001, 170-78) in view of Cardenas et al. (Arch Phys Med Rehabil, Vol. 83, Dec. 2002) as applied to claim 1 above, and in further view of Maw et al. (U.S. Patent 6,856,439).

Jain et al. and Cardenas et al. teach that sildenafil treats pain and that pain is associated with spinal cord injury.

Jain et al. and Cardenas et al. do not teach the route of administration or the dosage of sildenafil.

Maw et al. teach a pharmaceutically active compound comprised of a cGMP PDE5 inhibitor that is used to treat various disorders, including female sexual pain disorder and sexual dysfunction due to spinal cord injury (Col. 25, lines 13-20). They further teach that the compound will be administered orally (encompassing claim 2, Col. 25, lines 52-53) and a dose range of tablets as being between 0.01 mg and 500 mg (encompassing claim 3; Col. 27, lines 30-31).

It is therefore obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Jain et al., which teach that sildenafil is a cGMP PDE5 inhibitor and Cardenas et al. which teach that spinal cord injury is associated with pain, with the teachings of Maw et al. which teach a composition

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comprised of a cGMP PDE5 inhibitor to treat various disorders, including female sexual pain disorder and sexual dysfunction in patients suffering from spinal cord injury. One having ordinary skill in the art at the time the invention was made would be motivated to combine the teachings of Jain et al. and Cardenas et al. with Maw et al. to obtain an efficacious compound to alleviate pain associated with spinal cord injury.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

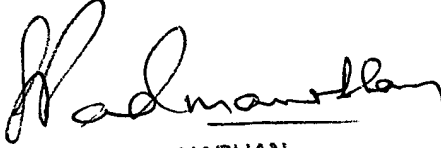
**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Renee Claytor whose telephone number is 571-272-8394. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Renee Claytor

  
SREENI PADMANABHAN  
DEPUTY PATENT EXAMINER